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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/837,357	04/18/2001	Koji Kato	01242/LH	8889
1933	7590	04/29/2005	EXAMINER	
FRISHAUF, HOLTZ, GOODMAN & CHICK, PC 767 THIRD AVENUE 25TH FLOOR NEW YORK, NY 10017-2023			GENCO, BRIAN C	
			ART UNIT	PAPER NUMBER
			2615	

DATE MAILED: 04/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/837,357	Applicant(s) KATO ET AL.	
	Examiner Brian C Genco	Art Unit 2615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11, 12, 15 and 16 is/are rejected.
- 7) ☒ Claim(s) 17 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 April 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>4/18/01</u> . | 6) <input type="checkbox"/> Other: _____ |

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Claims 1-10, 13, 14, and 18-21 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected Group I and nonelected Species I-III, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on December 28, 2004.

Examiner notes that claim 18 had been previously indicated as a generic claim, however under further consideration it is found to be directed to non-elected Species III. Furthermore, Examiner notes that claim 11 was previously indicated as being generic. More specifically Examiner herein notes that claim 11 is generic to Species II-IV.

The traversal is on the ground(s) that the various inventions and species are sufficiently related that the Examiner should be able to conduct a meaningful search without undue burden.

This is not found persuasive because of the separate classification of the two inventions claimed. Further, there is burden placed on the Examiner to search all of the multiple species claimed by Applicant.

The requirement is still deemed proper and is therefore made FINAL.

Drawings

Figure 14 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted

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by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Allowable Subject Matter

Claim 17 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any

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evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 11, 12, 15, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over (USPN 2005/0041137 to Ezawa et al.) in view of (USPN 6,031,998 to Shono).

In regards to claim 11 Ezawa discloses an electronic camera comprising:

a photographic lens configured to form an object (e.g., element 145 of Fig. 14);

an image sensing element configured to photoelectrically convert the formed object image (e.g., element 175 of Fig. 13, wherein this element is also shown in Fig. 14 but is not labeled);

an optical filter disposed between the photographic lens and the image sensing element (e.g., element 185 of Fig. 14);

a focal-plane shutter disposed between the photographic lens and the optical filter to mechanically interrupt incident light to the image sensing element (e.g., element 165 of Fig. 14).

a holding frame configured to surround the image sensing element (e.g., element 173 of Fig. 14).

Ezawa does not disclose the holding frame is configured to also surround the optical filter and to form a closed space between the image sensing element and the optical filter.

Shono discloses in Fig. 1 a similar image pickup unit as that illustrated in Fig. 14 of Ezawa. Examiner notes the description on column 3, lines 41-64 of Shono wherein Shono additionally has a sealing member 21 which makes an airtight seal such that foreign matter such

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as dust cannot enter the sealing member and therefore no foreign matter sticks to the surface of the filter. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to utilize the sealing member 21 of Shono such that foreign matter such as dust cannot enter the sealing member and stick to the surface of the filter.

In regards to claim 12 Ezawa discloses the camera further comprises a light guiding device disposed between the photographic lens and the optical filter to guide incident light from an object, which is incident from the photographic lens, to a first optical path to the image sensing element and a second optical path different from the first optical path (e.g., element 149 of Fig. 12).

In regards to claim 15 Ezawa discloses the light guiding device comprises an optical path switching device configured to switch first and second states in which the incident light is output to the first and second optical paths, respectively (e.g., element 149 is a movable mirror; paragraph 0055).

In regards to claim 16 Ezawa discloses the optical path switching device comprises a movable mirror (e.g., paragraph 0055).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian C. Genco who can be reached by phone at 571-272-7364 or by fax at 571-273-7364. The examiner can normally be reached on Monday thru Friday 8:30am to 4:30 pm.

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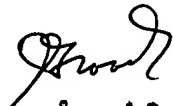
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Groody can be reached at 571-272-7950. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the customer service office whose telephone number is 571-272-2600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Brian C Genco
Examiner
Art Unit 2615

April 20, 2005


James J. Groody
Supervisory Patent Examiner
Art Unit 262-2615